

REMARKS

Examiner Basichas has rejected claims 1-9 and 11-13 of the present application. For the reasons which follow, applicant respectfully traverses this rejection of the Examiner. The applicant does, however, wish to extend appreciation to Examiner Basichas for the quite detailed review of the claims of the present invention leading to the finding of patentable subject matter of the claims of the present application and an indication of the allowance of claims 10 and 14-18.

Claim 13 has been placed in independent form by incorporating claim 1 as previously amended. Examiner Basichas concedes that Kurimaya does not suggest an audible message of the claimed duration. Although Semenکو discloses an audible message, it appears that Examiner Basichas concedes that Semenکو also does not suggest the claimed duration, but attempts to dismiss that deficiency based upon "a matter of design choice" or the "absence of criticality". However, it is respectfully submitted these are not proper grounds for rejection. Specifically, as to being critical, the Board of Appeals in Appeal No. 94-4450 in Application No. 07/945,247 stated:

The limitations in appellant's claims cannot simply be dismissed "since no showing of criticality has been made" (answer, page 2 and final rejection, page 3). It is not a prerequisite to patentability that the limitation in a claim be "critical". See W. L. Gore & Associates, Inc. vs. Garlock, Inc. 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983).

Examining the Gore decision, the Court of Appeals for the Federal Circuit held:

Garlock 's appeal argument that the '390 claims are invalid because the recited minimum matrix tensile strengths are not "critical"' is without merit. A claim to a new product is not legally required to include critical limitations. (case citation)

Thus, even if the limitations are not critical as contended by the Examiner, does not mean the present invention is obvious over the prior art.

As to design choice, as stated by the Patent Office Board of Appeals in *Ex parte Dere*, 118 U.S.P.Q. 541 (1957) at page 544:

It will be observed that the last sentence of the above quotation is a concession that the art contains no suggestion of having marked zones of perforation on

opposing edges spaced according to the metric or English systems respectively. The examiner, as to this relationship, which is the very thing that yields the useful results already pointed out merely states it:

'is not seen to provide a patentable distinction, being no more than a matter of choice.'

Why he so holds he does not say and we do not see particularly since only the disclosure of the instant case makes a 'choice' available.

In view of the fact that claimed relationship has the useful advantages already enumerated, we cannot agree with this undocumented statement.

Also, as stated in the report by the Subcommittee on Quality of Examination on page 323 of the January, February and March 1990 edition of the AIPLA Bulletin:

Are the Examiners even attempting to search for what they regard as "mere matters of design choice." Federal Circuit decisions such as In re Newell, No. 89-1332 (Fed. Cir. Dec. 12, 1989) and In re Kaplan, 229 U.S.P.Q. 678, 683 (Fed. Cir. 1986), show that the Federal Circuit has recognized the problem and will insist on the citation of relevant art. A rejection based on "mere design choice" should be supported by the prior art.

Particularly, as set forth In re Kaplan, 229 U.S.P.Q. 678, 683 (Fed. Cir. 1986):

In the later case [a mere variation of that invention which would have been obvious to those of ordinary skill in the relevant art], there must be some clear evidence to establish why the variation would have been obvious which can properly qualify as "prior art." Even if obviousness of the variation is predicated on the level of skill in the art, prior art evidence is needed to show what that level of skill was. (Bracketed material and emphasis added.)

The failure of the Examiner to in any way support that any other "design choice" is suggested by the prior art is a clear indication that the present invention is not obvious in view of the prior art. As set forth in the Background of Invention of the present application that a repeating message is annoying when several attempts are made before ignition is achieved, the claimed relationship of the present invention is advantageous. It is then respectfully submitted that the rejection of claims 2-9 and 11-13 under 35 U.S.C. § 103 has been overcome. Favorable reconsideration is respectfully requested.

The Examiner has cited the United States patents listed in NOTICE OF REFERENCES CITED as A-C in the Office action mailed October 3, 2005, and indicated consideration of the United States patents and publications cited by applicant. By the lack of application of these references and others like them within the classes or subclasses searched, the Examiner apparently recognizes the clear patentability of the present invention over any of these references.

Therefore, since the claims of the present application have been shown to include limitations directed to the features of applicant's cigarette lighter with alarm which are neither shown, described, taught, nor alluded to in any of the references cited by the Examiner and by the applicant, whether those references are taken singly or in any combination, the Examiner is requested to allow claims 2-18, as amended, of the present application and to pass this application to issue.

Respectfully submitted,

Arlo H. T. Lin



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Alan D. Kamrath, Reg. No. 28,227
NIKOLAI & MERSEREAU, P.A.
Attorneys for Applicant
900 Second Avenue South, Suite 820
Minneapolis, MN 55402
Tel: (612) 392-7306
Fax: (612) 349-6556